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UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

DMF, Inc., a California corporation,
Plaintiff,

v.

AMP Plus, Inc. d/b/a ELCO Lighting,
a California corporation; and

ELCO Lighting Inc., a California
corporation,

Defendants.

Case No. 2:18-cv-07090 CAS (GJSx)

**Notice of Judgment By Patent Trial
And Appeal Board Regarding
United States Patent No. 9,964,266**

Ctrm: 350 W. First. Street, Room 8D

Hon. Christina A. Snyder

1 On November 19, 2020, the Patent Trial and Appeal Board (“PTAB”) issued
2 its Judgment in Case No. IPR2019-01094 regarding United States Patent No.
3 9,964,266 (“the ’266 Patent”). The PTAB determined that Petitioner, Defendant
4 AMP Plus Inc. (ELCO), did “not demonstrate, by a preponderance of the evidence,
5 that claims 1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, and 28–30 are unpatentable.
6 Petitioner has demonstrated, by a preponderance of the evidence, that claim 17 is
7 unpatentable.”

8 The PTAB’s Judgment is attached hereto as Exhibit A.

9 Respectfully submitted,
10

11 By: /s/ David W. Long
12 David W. Long, Esq.

13 David W. Long
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15 Ben M. Davidson
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17 *Attorneys for Plaintiff*
18 *DMF Inc.*

19 Date: November 19, 2020
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Exhibit A

Trials@uspto.gov
571-272-7822

Paper 69
Date: November 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMP PLUS, INC., dba ELCO LIGHTING,
Petitioner,

v.

DMF, INC.,
Patent Owner.

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Patent 9,964,266 B2

Before CHRISTOPHER L. CRUMBLEY, JEFFREY W. ABRAHAM, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Claims 1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, 28–30
Not Unpatentable and Claim 17 Unpatentable
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

Denying-in-part and Dismissing-in-part as Moot Petitioner's Motion to
Exclude and Denying-in-part and Dismissing-in-part as Moot Patent
Owner's Motion to Exclude
37 C.F.R. § 42.64(c)

Granting Patent Owner's Unopposed Second Motion to Seal
37 C.F.R. § 42.54

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I. INTRODUCTION

This is a Final Written Decision in an *inter partes* review challenging the patentability of claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, and 28–30 (collectively, “the challenged claims”) of U.S. Patent No. 9,964,266 B2 (Ex. 1001, “the ’266 patent”). We have jurisdiction under 35 U.S.C. § 6. For the reasons that follow, we determine that Petitioner does not demonstrate, by a preponderance of the evidence, that claims 1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, and 28–30 are unpatentable. Petitioner has demonstrated, by a preponderance of the evidence, that claim 17 is unpatentable.

A. Procedural History

ELCO Lighting (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, and 28–30 of the ’266 patent.” Paper 1 (“Pet.”). On Nov. 20, 2019, we instituted trial on three grounds of unpatentability asserted in the Petition:

(1) Whether claims 1, 2, 4–11, 13, 15–17, 19, 21, and 26 of the ’266 patent are unpatentable under 35 U.S.C. § 102 as anticipated by Imtra 2011¹;

(2) Whether claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, 28–30 of the ’266 patent are unpatentable under 35 U.S.C. § 103 as obvious over Imtra 2011 and Imtra 2007²; and

¹ Imtra Marine Lighting– Advanced LED Solutions (“Imtra 2011”). Ex. 1005.

² Imtra Marine Lighting – Spring 2007 (“Imtra 2007”). Ex. 1006.

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(3) Whether claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, 28–30 of the '266 patent are unpatentable under 35 U.S.C. § 103 as obvious over Imtra 2011, Imtra 2007, and Gifford.³

Paper 20 (“Institution Decision” or “Inst. Dec.”).

Following institution, DMF, Inc. (“Patent Owner”) filed a Response (Paper 29, “Resp.”), Petitioner filed a Reply (Paper 42, “Reply”), and Patent Owner filed a Surreply (Paper 49, “Surreply”).

Petitioner supports its Petition with the declaration testimony of Dr. Eric Bretschneider (Ex. 1002) and Colby Chevalier (Ex. 1008). Patent Owner took cross-examination of the declarants via deposition and filed the transcripts (Dr. Bretschneider at Ex. 2047; Mr. Colby at Ex. 2045).

Patent Owner relies on the declaration testimony of James R. Benya (Ex. 2001). Petitioner took cross-examination of Mr. Benya via deposition and filed the transcript (Ex. 1038). Patent Owner filed a “corrected” version of the transcript (Ex. 2108).⁴

Petitioner filed a Motion to Exclude certain evidence submitted by Patent Owner (Paper 53, “Pet. Mot. Exclude”), after which Patent Owner

³ U.S. Patent No. 9,366,418 B2 to Gifford, published Apr. 4, 2013 (“Gifford”). Ex. 1007.

⁴ Mr. Benya’s deposition was conducted remotely. Ex. 1038, 5:1. The transcript reveals occasional difficulty hearing or understanding one or more of the speakers. *See, e.g., id.* 5:20–24, 36:18–37:24. Patent Owner requested filing a corrected version of the transcript, and did so as Ex. 2108. The only difference between Ex. 1038 and Ex. 2108 that we have identified is at page 106, line 19, where Ex. 1038 shows the transcription as “wouldn’t” and Ex. 2108 shows the transcription as “would.” We do not rely on Mr. Benya’s testimony at page 106, nor have we identified any difference in the two versions of Mr. Benya’s testimony upon which we rely.

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filed an Opposition (Paper 56, (“PO Opp. Exclude”), and Petitioner filed a Reply (Paper 60, “Pet. Reply Exclude”). Patent Owner filed a Motion to Exclude (Paper 59,⁵ “PO Mot. Exclude”), Petitioner filed an Opposition (Paper 55, (“Pet. Opp. Exclude”), and Patent Owner filed a Reply (Paper 61, “PO Reply Exclude”).

Both parties requested oral argument. Papers 51, 52. Argument was heard on September 10, 2020, and a transcript (Paper 68) has been entered into the record.

Patent Owner filed an unopposed Motion to Seal Paper 49 and Exhibits 2061–2073, 2075, 2076, 2088, 2090, and 2110. Paper 67.

B. Related Matters

Patent Owner indicates that the ’266 patent is the subject of a concurrent proceeding in the United States District Court for the Central District of California: *DMF, Inc. v. AMP Plus, Inc.*, Case No. 2:18-cv-07090 (the “District Court case”). Paper 29, 5. In response to the threat posed by COVID-19, the District Court continued the trial, with no new trial date set to our knowledge. Paper 34.

⁵ Due to a clerical error, Patent Owner served its Motion to Exclude on Petitioner on Aug. 20, 2020, but did not properly file it with the Board. Petitioner filed an Opposition to Patent Owner’s Motion to Exclude on Aug. 27, 2020. Upon discovery of the faulty filing, Patent Owner requested permission to file its Motion to Exclude after the due date. Because Patent Owner timely served Petitioner with the motion, and Petitioner did not object to the late filing, we permitted Patent Owner to make the late filing, resulting in Petitioner’s Opposition being filed *before* Patent Owner’s Motion.

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C. The '266 Patent

The '266 patent, titled “Unified Drive and Light Source Assembly for Recessed Lighting,” issued May 8, 2018, and claims priority to provisional application 61/843,278, filed July 5, 2013. Ex. 1001, codes (10), (45), (54), (60). The patent describes a compact recessed lighting system comprising a light source module and a driver separately coupled to a unified casting, and a reflector. *Id.*, Abstract. According to the '266 patent, recessed lighting systems are typically installed or mounted into an opening in a ceiling or a wall, and comprises a trim, a light source module, a “can” housing, and a driver, with the driver insulated from other portions and components of the lighting system through use of a separate insulating container. *Id.* at 1:27–33. The driver may be coupled to the light source module through the use of wires or other conduits such that the driver powers the light source module to emit light. *Id.* at 1:33–36. Separation between the driver and the light source module adds to the size of the recessed lighting system, increasing the size of the system to be placed in constrained spaces and possibly increasing cost. *Id.* at 1:37–46.

The '266 patent purports to provide a lighting system with a more compact and cost-effective design while complying with all building and safety codes/regulations. *Id.* at 2:10–13. The light source module, driver, unified casting, reflector, and lens are used with junction boxes and trims. *Id.* at 2:13–17.

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D. Illustrative Claim

Claims 1, 17, 22, and 26 are independent claims of the '266 patent. Claim 1 illustrates the subject matter of the challenged claims and reads as follows:

1. A compact recessed lighting system, comprising:
 - a light source module for emitting light;
 - a driver for powering the light source module to emit light, the driver including an electronic device to at least one of supply and regulate electrical energy to the light source module;
 - a unified casting with a heat conducting closed rear face, a heat conducting sidewall and an open front face

wherein the heat conducting sidewall is joined to the heat conducting closed rear face at one end and defines the open front face of the unified casting at another end,

wherein the heat conducting sidewall has a first dimension between the heat conducting closed rear face and the open front face of less than 2 inches and extends 360 degrees around a center axis of the unified casting to define a first cavity that extends forward from the heat conducting closed rear face to the open front face of the unified casting and outward to the heat conducting sidewall,

wherein the light source module and the driver are positioned inside the first cavity while being coupled to the heat conducting closed rear face of the unified casting such that the light source module is closer to the closed rear face of the unified casting than the open front face of the unified casting, and

wherein the unified casting includes a plurality of elements positioned proximate to the open front face so as to align with corresponding tabs of a standard junction box and thereby facilitate holding the unified casting up

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against the standard junction box when the unified casting is installed in the standard junction box; and

a reflector positioned inside the first cavity of the unified casting and coupled to and surrounding the light source module such that the reflector directs light produced by the light source module into an area surrounding the compact recessed lighting system while enclosing the driver from exposure to the area surrounding the compact recessed lighting system,

wherein the heat conducting closed rear face and the heat conducting sidewall of the unified casting significantly dissipate heat generated by the light source module during operation of the light source module.

Ex. 1001, 8:2–44 (formatting added).

Independent claims 17, 22, and 26 are similar to claim 1 in that they each require a light source module, a driver, a unified casting, and a reflector. *Id.* at 10:3–34, 11:4–43, and 12:9–31. Significantly, claim 17 does not require a unified casting including a plurality of elements positioned proximate to the open front face so as to align with corresponding tabs of a standard junction box, as claim 1 requires.

II. DISCUSSION OF UNPATENTABILITY CHALLENGES

Petitioner bears the burden of proving unpatentability of the challenged claims, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must establish the facts supporting its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). Below, we discuss whether Petitioner has met its burden with respect to the challenged claims.

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A. Principles of Law

A claim is unpatentable under 35 U.S.C. § 102(a)(1) if the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The level of ordinary skill in the art may be reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

B. Level of Ordinary Skill in the Art

We consider each asserted ground of unpatentability in view of the understanding of a person of ordinary skill in the art (“POSITA”). *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361 n.3 (Fed. Cir. 2008) (“What a prior art reference discloses or teaches is determined from the perspective of one of ordinary skill in the art.”) (citing *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991)).

Petitioner and Dr. Bretschneider contend that a POSITA at the time of the invention would have had “at least a B.S. degree or equivalent in

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electrical engineering, mechanical engineering, chemical engineering, physics, or a related field” and “at least 2–3 years of experience in designing LED lighting products or fixtures.” Pet. 20; Ex. 1002 ¶¶ 24–25.

Patent Owner and Mr. Benya conclude that a POSITA “would need experience and working knowledge of the safety and other building codes and standards governing recessed lighting in residential and commercial buildings, which impacts recessed lighting design and terminology.” Resp. 7; Ex. 2090 ¶ 31⁶.

We find that the art involved in the ’266 patent is recessed lighting. We do not limit the art to recessed lighting in residential and commercial buildings, as Patent Owner seems to propose. *See* Resp. 7. We find that a POSITA would have the educational background proposed by Petitioner, as well as knowledge and experience of building and safety codes/regulations as proposed by Patent Owner. Other differences between the parties’ proposed definitions are not significant to this Decision.

C. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Under that standard, we construe the claims in accordance with the ordinary and customary meaning of such claim, as would have been understood by one of ordinary skill in the art at

⁶ Exhibit 2090 is Mr. Benya’s Feb. 13, 2020 declaration. Exhibit 2094 is a version of Mr. Benya’s declaration in which confidential business information has been redacted at paragraphs 129–142, 144–146, 151, and 159. It is otherwise identical to Exhibit 2090. In this Decision, we refer to Exhibit 2090, as this is the exhibit used in the briefing. We do not rely on any paragraphs in Exhibit 2094 that contain redactions.

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the time of the invention, in light of the specification and prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner addresses the construction of “driver” in the Petition (Pet. 22–26) and of “driver” and “standard junction box” in the Reply (Reply 2–8). Patent Owner offers a construction of “standard junction box,” “driver,” and “unified casting.” Resp. 36–43; Sur-Reply 1–12. “Driver” and “unified casting” are recited in all challenged claims. *See* Ex. 1001, 8:1–12:61. “Standard junction box” appears in independent claims 1 and 26, as well as in claims 19 and 21 (both depending from claim 17) and claim 25 (depending from claim 22). *See id.* We analyze “standard junction box” and “driver” below. The parties do not make any argument that requires construction of “unified casting.” We determine that no other terms require express construction.

1. *standard junction box*

Although the term “standard junction box” occurs in independent claims 1 and 26, it is not a structural limitation of either claim. *See* Ex. 1001, 8:2–12:62. For example, claim 1 requires “a plurality of elements” included in the unified casting configured “so as to align with corresponding tabs of a standard junction box” “when the unified casting is installed in the standard junction box.” *Id.* at 8:23–33. Claim 26 requires a unified casting “having dimensions to fit inside a standard-sized junction box.” *Id.* at

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12:10–13. Claim 26 imposes dimensions on the unified casting but does not limit the claimed system to one including a standard junction box as part of the claimed system. *See id.*

Patent Owner urges construction of the term “consistent with the district court’s Claim Construction Order at 24–27 (Ex. 2015) as an ‘industry-specified size’ ‘shell or enclosure for accommodating wire splices to building main power and separating them from other items inside a ceiling or crawl space.’” Resp. 36 (quoting Ex. 2015, 24–27).

Patent Owner emphasizes that “standard junction box” should be limited to accommodating wire splices to *building main power*, supporting this construction with references to the Specification, file history, and Dr. Bretschneider’s testimony. *Id.* at 36–37. According to Patent Owner, both the Specification and file history “explain[] the importance of *building* codes to the claimed invention.” *Id.* at 7–18, 36–37. Patent Owner directs us to instances in the Specification indicating the disclosed invention complies with “all building and safety regulations.” *Id.* at 7–10, 36–37. In similar fashion, Patent Owner directs us to portions of the file history amending claims to add “standard junction box” and conveying the applicant’s report of an interview with examiners of the application leading to the ’266 patent. Resp. 10–18, 36–37. Finally, Patent Owner argues that Dr. Bretschneider conceded that (1) it is important for a POSITA to be familiar with building codes in order to understand the ’266 patent invention; (2) junction boxes are used for making a connection to a building main power; and (3) junction boxes are not required for low-voltage devices. *Id.* at 18–19, 37.

Although Petitioner does not challenge Patent Owner’s contention that a “standard junction box” means one having “industry-specified size,” it

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disputes that a standard junction box is limited to one that connects to building main power. *See* Reply 2–5. Petitioner argues that none of the claims require a standard junction box, most of the claims do not require the claimed system be used in a building, and the Specification broadly defines “junction box.” *Id.* Noting that the claims do not require compliance with codes, Petitioner contends that whether a junction box has a fire rating, meets building and safety codes, or is to be used in a residential or commercial building has no bearing on the proper construction of “standard junction box.” *Id.* at 5. Petitioner also argues that Patent Owner mischaracterizes Dr. Bretschneider’s testimony, asserting that he testified that to understand the invention of the ’266 patent it was important to be familiar with UL safety standards for designing lighting products (i.e., not that it was important to be familiar with building and safety codes), and whether junction boxes are required for low voltage DC depends on the installation. *Id.*

In the Sur-Reply, Patent Owner counters Petitioner’s position that the Specification broadly discloses a junction box, pointing out the Specification “refers to the junction box being used for high voltages ‘e.g., 120 VAC or 277 VAC’ (typically called *building mains*).” Sur-Reply 1–2. Patent Owner also points out that Petitioner fails to address the file history in its Reply. *Id.* at 4. In addition, Patent Owner argues that extrinsic evidence⁷ supports its

⁷ Patent Owner identifies paragraphs of Mr. Benya’s declaration (Ex. 2090), the Gifford patent (Ex. 1007), the file history of the application leading to the Gifford patent (not of record), Mr. Benya’s deposition testimony (Ex. 2108), Mr. Benya’s testimony in the district court case, and Dr. Bretschneider’s testimony (Ex. 2047). Sur-Reply 2–3, 5–9.

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construction. *Id.* at 2–3, 5–9.

The construction of “standard junction box” impacts whether the claimed compact recessed lighting system is limited to “building main power” as a power source. Patent Owner argues that the term is so limited (Response 36–37), thus avoiding prior art that reads on marine lighting systems that arguably do not use building main power as a power source. Petitioner, asserting the marine lighting systems as prior art, argues Patent Owner’s proposed construction is too narrow. Reply 2–5.

“[C]laim construction must begin with the words of the claims themselves.” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1301 (Fed. Cir. 2006). “[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms,” however, they “do not stand alone.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314–15 (Fed. Cir. 2005) (en banc). “The words used in the claims are interpreted in light of the intrinsic evidence of record, including the written description, the drawings, and the prosecution history” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002). The specification, “always highly relevant to the claim construction analysis,” “is the single best guide to the meaning of a disputed term.” *Phillips*, 415 F.3d at 1315. In addition, “the prosecution history provides evidence of how the [PTO] and the inventor understood the patent.” *Id.* at 1317. Our reviewing court cautions, however, that “because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Id.*

We may also look to extrinsic evidence in the form of expert

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testimony to, among other things “provide background on the technology at issue” or “establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.” *Id.* at 1318. Extrinsic evidence is, however, generally viewed as less reliable than intrinsic evidence in determining the proper construction of a claim term. *Id.*

Looking first to the language of independent claims 1 and 26, we find that a standard junction box has tabs, and the unified casting has a plurality of elements that align with those tabs to facilitate holding the unified casting up against the standard junction box when it is installed in the standard junction box. Ex. 1001, 8:28–33; 12:13–16. We find nothing in these claims that expressly states or otherwise implies that a standard junction box is limited to one accommodating wire splices to “building main power.”⁸ *See* Resp. 36.

The Specification describes a junction box generally as “a shell or enclosure” and an alternative “housing” to a “can” housing structure. Ex. 1001, 3:12 and 7:19–20. The size of the cavity of the junction box “may be pursuant to popular industry specifications for junction boxes.” *Id.*, 3:2–5. The Specification indicates a junction box may be part of the recessed lighting system, and describes embodiments of a junction box as separating the inner components of the recessed lighting system (including electrical wires/cables) from the items inside a ceiling or crawl space; being coupled to a stud, beam, or other structural member inside a ceiling or crawl space;

⁸ In contrast, we note that claims 10, 16, 22, and 25 recite an electrical system *of a building*, indicating that the inventors added the requirement of a building where they chose to limit the claims to that environment.

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equipped with one or more bar-hangers to assist installation when the junction box needs to be located between two studs or joists; a single or double gang box with a fire rating of up to two hours under specified codes; receiving electrical wires from an electrical system within a building or structure; and acting as a heat barrier to block heat emitted by the light and the driver. *Id.*, 2:19–39; 2:55–57.

Thus, the Specification conveys that the standard junction box is an industry-specified shell, enclosure, or housing with identified permissive capabilities. However, the claims and Specification together do not expressly require that a standard junction box be limited to those that perform all of the identified functions, as all of the functional language is permissive and appears in the Specification, but not in the claims. Structural claims, such as claims directed to an article or apparatus, must be distinguished from the prior art in terms of structure. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) and cases cited therein; *see also In re Danly*, 263 F.2d 844, 848 (CCPA 1959) (“Claims drawn to an apparatus must distinguish from the prior art in terms of structure rather than function”); *In re Gardiner*, 171 F.2d 313, 315-16 (CCPA 1948) (“It is trite to state that the patentability of apparatus claims must be shown in the structure claimed and not merely upon a use, function, or result thereof.”). At the oral hearing, counsel for Patent Owner confirmed that it is the structural features of the unified casting that are important for purposes of infringement, not whether a standard junction box is connected to building main power:

That term standard junction box conveys a lot of meaning. That’s its role, that’s why you’re having it align with the tabs of the standard junction box because this is a device that could be

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put in a standard junction box and we've just got to be careful not to confuse that with what you need to prove infringement. But if you sell a device that has these features, you infringe whether you put it in a junction box or not, we agree with that.

Tr. 44–45; *see also id.* at 46 (counsel agreeing that “you wouldn’t have to have a junction box in your hand” to determine infringement of claim 1 and agreeing that you don’t need to actually connect a device that fits a standard junction box to building main power to infringe claim 1); *Kimberly-Clark Corp. v. Johnson and Johnson*, 745 F. 2d 1437, 1448–49 (Fed. Cir. 1984) (“Regardless of how patent claims may be arrived at during the vicissitudes of prosecution, the invention patented is no more and no less than what the finally issued claims, as construed by the court, define; and they must be construed in the identical way for both infringement and validity.”).

Patent Owner’s argument that the Specification and file history “explain[] the importance of building codes to the claimed invention” does not persuade us that a standard junction box is restricted to use only in association with *building main power*. Compare Resp. 7–10 with 36–37. The Specification indicates that the recessed lighting system complies “with all building and safety codes/regulations.” Ex. 1001, Abstract, 2:12–14, 3:5–6, 6:10–11, 7:21–22. The Specification also discloses that the junction box in certain embodiments of the invention receives electrical wires from the electrical system of a building or structure. *Id.* 2:33–36, 3:56–58. We do not agree that these statements should be read in combination to create the restriction on the junction box urged by Patent Owner. Patent Owner’s arguments ignore the Specification’s use of both “building” and “structure,” which reasonably indicates to a person of ordinary skill in the art that a “structure” may be something different than a “building.” Likewise, the

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Specification's use of building *and* safety codes/regulations, leaves open the possibility that there are safety codes/regulations that apply to structures other than buildings.

The prosecution history also does not support limiting the standard junction box to one used only in conjunction with building main power. *See* Resp. 10–16, 36–37. Following a Request for Continued Examination, Applicant amended some of the pending claims to recite “a unified casting includes a plurality of elements . . . [that] align with corresponding tabs of a standard junction box,” also adding new claims with the same requirement. Ex. 2044, 1037, 1042–43, 1045, 1048. According to the report of a January 24, 2018 interview with examiners, Applicant began with a presentation on “the technical subject matter underlying the claims, *including* a description of the state-of-the-art in residential and commercial lighting.” *Id.* at 1053 (emphasis added). Applicant described “his recognition of various challenges arising from applicable building codes and fire-related safety standards for recessed lighting (particularly in multiple dwelling units or ‘multifamily construction’), which *in part* provided the basis” for the invention. *Id.* at 1053 (emphasis added). Applicant further stated:

In the single-housing solution provided by Inventor Danesh's innovative assembly, building wiring carrying the AC “mains” voltage *may* be coupled to the driver inside the unified casting via wire nuts or connectors inside the junction box, as illustrated in Fig. 1 of the present application. In the context of a built environment including multiple lighting fixtures, the wiring for multiple junction boxes containing respective unified castings *may* be daisy-chained together and thereby meet both applicable building and electrical codes and fire safety standards without requiring the labor-intensive construction of multiple fire-boxes. *Id.* at 1056 (emphasis added).

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Applicant's representations in the interview do not suggest that Applicant narrowed the scope of the claims as Patent Owner contends. The use of the words "may," "including," and "in part" imply that Applicant's discussion was intended to identify some of the more restricted uses of the invention (e.g., in multifamily construction), but do not signal an intent to unreservedly limit the invention to the embodiments described. *See In re DiLeone*, 436 F.2d 1404 (CCPA 1971) (interpreting "may" in the specification's disclosure of "a diamine which may be either an aliphatic diamine or an aromatic diamine" as illustrative, not as limiting the description of diamines to only aliphatic and aromatic diamines); *see also Clark v. Wright Aeronautical Corp.*, 162 F.2d 960, 962 (2nd Cir. 1947) (Learned Hand, J.) ("It has become a habit of the scriveners of patent applications to use the permissive form, presumably lest they should too much limit the invention; but in doing so they risk impaling themselves upon the other horn of the dilemma, because the specification must contain adequate instructions for the practice of the invention, and permission may easily become imprecision."). Again, as indicated in claims 10, 16, and 22, to the extent the inventors wished to limit their claimed lighting system to those connected to the electrical system of a building, they knew how to expressly do so, and indeed chose to do so only in a small subset of its claims.

Our reviewing court has made clear that the scope of claim language is not to be limited by prosecution history that does not clearly and deliberately call for a narrower definition. *See N. Telecom Ltd. v. Samsung Elecs. Co.*, 215 F.3d 1281, 1294 (Fed. Cir. 2000) (holding that prosecution history statements did not provide a narrowing definition "with reasonable

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clarity and deliberateness”); *see also In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.”); *see also Purdue Pharma L.P. v. Endo Pharm. Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006) (declining to narrow the scope of a claim term by adding a specific feature to the definition where the applicant had not described the feature as “necessary” to the claimed invention during prosecution). Indeed, “because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Phillips*, 415 F.3d at 1317 (citing *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1380–81 (Fed. Cir. 2002) (the ambiguity of the prosecution history made it less relevant to claim construction) and *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996) (the ambiguity of the prosecution history made it “unhelpful as an interpretive resource” for claim construction)).

We find no disavowal of claim scope “with reasonable clarity and deliberateness” in the prosecution history in this case sufficient to overcome the heavy presumption that “standard junction box” carries its ordinary meaning.

The expert testimony before us is also insufficient to persuade us that a standard junction box implies connection only to building main power.

Patent Owner contends that Petitioner’s expert, Dr. Bretschneider, testified that (1) it is important to be familiar with building and safety codes in order to understand the invention of the ’266 patent; (2) junction boxes

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are used for making a connection to building main voltage; and (3) junction boxes are not required for low-voltage devices. Resp. 37. We note that Patent Owner takes some liberties in summarizing Dr. Bretschneider's testimony. Our review of Dr. Bretschneider's deposition reveals he testified that (1) the '266 patent mentions being familiar with building codes; (2) junction boxes for recessed lights under UL standard 1598 are used to make a connection between main power and the lighting fixture and, in some cases junction boxes may simply be used for connections of wires; and (3) depending on the installation, a UL junction box may not be required for low voltage light fixtures. Ex. 2047, 27:7–12; 25:12–22; 118:5–18. Contrary to Patent Owner's assertion, Dr. Bretschneider's testimony does not support Patent Owner's construction of standard junction box. Rather, it indicates that a UL junction box may be used for making a connection to building main power, and that the '266 patent mentions being familiar with building codes. We are not persuaded that this testimony supports limiting the claims as Patent Owner proposes.

Patent Owner's expert, Mr. Benya, testified that a "junction box used in residential or commercial buildings is understood by a person of ordinary skill in the art to be a basic wiring system element and safety device required by building codes to isolate splicing together of lighting fixture wires to building main voltage." Ex. 2090 ¶ 55. Mr. Benya's testimony, however, is premised on a junction box being used in residential or commercial buildings. *Id.* Dr. Bretschneider testified that the '266 patent is not restricted to recessed lighting systems for use in residential or commercial buildings. *See* Ex. 1002 ¶ 27. As discussed above, the '266 patent Specification addresses use of the lighting system with electrical systems in

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a building or structure, not only “residential or commercial buildings” which is not a term included in the Specification. *See* Ex. 1001; 3:56–58. Mr. Benya’s testimony does not directly address the question of the construction of “standard junction box” in the claims of the ’266 patent.

Based on our review of the intrinsic and extrinsic evidence, we construe “standard junction box” to mean “a shell or enclosure or housing of industry-specified size for containing electrical connections.”

We recognize that the District Court adopted a different construction of standard “junction box,” namely “a shell or enclosure for accommodating wire splices to building main power and separating them from other items inside a ceiling or crawl space.” Ex. 2015, 24–27. We, however, give more weight to the language of the claims themselves and less to the declaration of Mr. Benya. We contrast the absence of “building main power” in independent claims 1 and 26 with the express recitation of a connection to the electrical system of a building in claims 10, 16, and 22. We also assign importance to the use of the phrase “or structure” in addition to “building” in the Specification, which we find to be relevant to the question of whether a standard junction box is limited to the use in commercial or residential buildings. Furthermore, although we do not address the issue of infringement, the Federal Circuit has instructed that claims should be construed the same way for purposes of validity and infringement. In view of Patent Owner’s concession that a connection to building main power is not needed to prove infringement, we fail to see why it should be integrated into the meaning of standard junction box for purposes of validity. For these reasons, and those discussed above, we respectfully disagree with the District Court’s construction. *See generally* Ex. 2015 and 2095.

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2. *driver*

Independent claims 1, 17, and 22 recite “a driver for powering the light source module to emit light, the driver including an electronic device to at least one of supply and regulate electrical energy to the light source module.” Ex. 1001, 8:4–7, 10:5–8, 11:6–9. Claim 26 recites “a driver, disposed in the casting cavity, to power the light source module.” *Id.* at 12:22–23.

Petitioner urges construction of “driver” as “an electronic device to supply and/or regulate electrical energy to the light source module.” Pet. 23. Petitioner supports its proposed construction with reference to the Specification of the ’266 patent:

The driver 4 is an electronic device that supplies and/or regulates electrical energy to the light source module 3 and thus powers the light source module 3 to emit light. The driver 4 may be **any type** of power supply, including power supplies that deliver an alternating current (AC) **or a direct current (DC) voltage** to the light source module 3.

Id. at 24 (quoting Ex. 1001, 4:21–27 (emphasis added by Petitioner)).

Petitioner also argues that industry standards support its construction of “driver.”⁹ Pet. 25. Dr. Bretschneider testifies that Petitioner’s proposed

⁹ Petitioner quotes (1) ANSI/IES (Illuminating Engineering Society) RP-16-10 Standard (2010), *Nomenclature and Definitions of Illuminating Engineering*, 25, defining LED driver as “a device comprised of a power source and LED control circuitry designed to operate a LED package (component), or an LED array (module) or an LED lamp” (Ex. 1010); and (2) Underwriters Laboratories Inc. Standard for Safety UL-8750 (2009), *Light Emitting Diode (LED) Equipment for Use in Lighting*, defining LED driver as “a power source that adjusts the voltage or current to LEDs, ranging in complexity from a resistor to a constant voltage or constant current power supply” (Ex. 1011). Pet. 25.

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construction “is entirely consistent with the definitions of driver codified in industry standards.” Ex. 1002 ¶¶ 90–94. Dr. Bretschneider also testifies that a POSITA would have been aware that the ’266 patent is not restricted to any particular input electrical power source, and that industry standard definitions of an LED driver do not limit a driver to 120 VAC or 277 VAC. *Id.* ¶ 98.

Petitioner contends that the ’266 patent “repeatedly states that the lighting system may be installed in a building or *structure*,” thus is not limited to use in commercial or residential environments. Pet. Reply 2. According to Petitioner, the ’266 patent covers lighting systems used in any form of building or structure, including houseboats, yachts, ships, etc. *Id.* at 3 (citing Ex. 1002 ¶¶ 26–27). Dr. Bretschneider testifies that the scope of the ’266 patent is not restricted to a particular field of lighting, and a POSITA would have understood that embodiments of the ’266 patent “are relevant to any form of structure used or occupied by people.” Ex. 1002 ¶ 27.

Patent Owner seeks construction of “driver” as “a device that serves the function of supplying and regulating electrical energy *from building main power* to the light source module.” Resp. 40 (emphasis added). Patent Owner quotes two portions of the Specification:

driver 4 receives an input current from the electrical system of the building or structure in which the recessed lighting system 1 is installed and drops the voltage to an acceptable level for the light source module 3 (e.g., from 120V–240V AC to 36V–48V DC).

* * *

The driver 4 may be any type of power supply, including power supplies that **deliver** an alternating current (AC) or a direct current (DC) voltage to the light source module.

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Id. (quoting Ex. 1001, 4:38–43; 4:23–27 (emphasis added by Patent Owner)). Patent Owner adds that Dr. Bretschneider testified that the second quote means that the output of the driver may be AC or DC. *Id.* (citing Ex. 2047, 127:20–128:10).

Patent Owner also relies on remarks in the report of the examiner interview discussed above:

In the single-housing solution provided by Inventor Danesh’s innovative assembly, **building wiring carrying the AC “mains” voltage may be coupled to the driver** inside the unified casting via wire nuts or connectors inside the junction box, as illustrated in Fig. 1 of the present application.

Id. at 41 (quoting Ex. 2044, 1056 (emphasis added by Patent Owner)). Patent Owner characterizes the statement as confirming that the claimed driver is coupled to “building wire carrying AC ‘mains’ voltage.” *Id.*

Patent Owner contends that Dr. Bretschneider agreed that the context in which the term “driver” is used is important to understand its meaning, and that it may have different meanings in different contexts. *Id.* (citing Ex. 2047, 85:15–87:1).

In the Reply, Petitioner argues that Dr. Bretschneider’s testimony that the driver *outputs* AC or DC power does not mean that the driver cannot have AC or DC *input*. Reply 6 (citing Ex. 2047, 127:20–128:10 and Ex. 1038, 97:21–98:3). Petitioner also points to Mr. Benya’s testimony that the driver in the Specification can *receive* AC or DC. *Id.* (citing Ex. 1038, 104:5–21). Petitioner argues that not all of the claims require the claimed lighting system to be installed in a building, citing Mr. Benya’s agreement with this position. *Id.* (citing Ex. 1038, 61:11–16; 82:7–83:9).

In the Sur-Reply, Patent Owner argues that Mr. Benya testified that (1) building mains would not be low-power DC, and (2) he was unsure

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whether the Specification’s statement that “[t]he driver 4 is an electronic device that supplies and/or regulates electrical energy to the light source module 3 and thus powers the light source module 3 to emit light” is a complete definition. Sur-Reply 10–11. Patent Owner also states that “[t]he parties agree that the ‘electrical system of a building’ would be building mains,” but provides no evidentiary support for the assertion of agreement. *Id.* at 11.

The ’266 patent discloses embodiments in which the lighting system is within “a building or structure” (*see, e.g.*, Ex. 1001, 2:34–36, 4:3–4), but neither the Specification nor the prosecution history expressly restricts the lighting system to being *only* within a building—and “structure” is undefined. Where desired, the Applicant drafted the claims to limit the recessed lighting system to one placed or installed in a building. *See, e.g.*, Ex. 1001, 11:4–5, 11:35–43 (Claim 22 requires electrical connection between the driver and “electricity from an electrical system of a building.”). In other claims, however, the plain language supports a recessed lighting system powered by electricity from, or installed in, a structure that is not expressly limited to a building. *Compare id.* at 9:65–67 (claim 16: “a trim directly coupled to the unified casting, for covering a hole in a ceiling or wall of a building”), *with id.* at 10:22–23 (claim 17: “the light source module and the driver are positioned inside and completely contained within the cavity of the unified casting such that . . . the light source module . . . sits behind a ceiling or a wall when the unified casting is installed in a hole in the ceiling or the wall”). Thus, not all claims expressly recite a limitation that restricts placement of the recessed light system to within a building. *See, e.g., id.* at 10:3–34 (claim 17).

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Our review of the evidence before us supports that the driver is not limited to a device that requires connection to *building main power*, as proposed by Patent Owner. *See* Resp. 40. The driver is broadly described in the Specification as “an electronic device that supplies and/or regulates electrical energy to the light source module . . . and thus powers the light source module . . . to emit light,” and “may be any type of power supply.” Ex. 1001 4:21–24. The only page of the prosecution history referenced by either party states that “[i]n the single-housing solution provided by Inventor Danesh’s innovative assembly, building wiring carrying the AC ‘mains’ voltage may be coupled to the driver inside the unified casting via wire nuts or connectors inside the junction box, as illustrated in Fig. 1 of the present application.” *See* Resp. 41 and Reply 6–7 (both citing Ex. 2044, 1056). Petitioner argues that the sentence describes one embodiment in which the claimed lighting system may be installed in a building having AC mains and does not otherwise limit the broad language of the claims and Specification. Reply 7. Patent Owner argues “the term ‘may be’ modifies the word ‘inside’ (not ‘coupled to driver’).” Sur-Reply 11.

“In the absence of an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning.” *Starhome GmbH v. AT & T Mobility LLC*, 743 F.3d 849, 857 (Fed. Cir. 2014).

On the record before us, we see no persuasive reason to adopt the narrow construction of “driver” proposed by Patent Owner. “Driver” as used in the ’266 patent is not limited to a device that receives electrical power from building main power, but is more broadly construed: an electronic device to supply, regulate, or supply and regulate electrical energy

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to a light source module. Such construction is “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *See* 37 C.F.R. § 42.100(b).

On this record, no other claim terms require express construction. *See Vivid Techs.*, 200 F.3d at 803.

D. Asserted References

Before turning to Petitioner’s asserted grounds, we provide a brief summary of the asserted references.

1. Imtra 2011

Imtra 2011 is titled *Imtra Marine Lighting – Advanced LED Solutions* (Ex. 1005). The document is a brochure on LED and halogen lighting fixtures available for use in a variety of marine applications.

Petitioner contends the document is § 102(a)(1) prior art because it allegedly was published and widely distributed as early as May 26, 2012, prior to the earliest effective filing date of the ’266 patent. Pet. 4.

Patent Owner does not dispute the prior art status of Imtra 2011, but questions its applicability to the claims at issue. Resp. 28–29.

2. Imtra 2007

Imtra 2007 is titled *Imtra Marine Lighting – Spring 2007* (Ex. 1006). Imtra 2007 is a brochure on marine lighting fixtures, including LED, halogen, and fluorescent lighting fixtures. *See generally* Ex. 1006.

Petitioner contends that Imtra 2007 was published and widely disseminated by Imtra Corporation at least as early as 2007 and, therefore, qualifies as §102(a)(1) prior art to the ’266 patent. Pet. 4.

Patent Owner does not dispute the prior art status of Imtra 2007. *See*

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Resp. 30.

3. *Gifford*

U.S. Patent No. 9,366,418 B2 to Graham Gifford titled “Method, Apparatus, and System for Connecting a Light Emitting Diode Light Fixture to a Mains Power Conductor” issued on June 14, 2016, from an application published on April 4, 2013, before the effective filing date of the ’266 patent. Ex. 1007, code (54). Therefore, Gifford qualifies as prior art to the ’266 patent at least under §102(a)(1).

E. Ground 1: Anticipation by Imtra 2011

Petitioner, relying on the testimony of Dr. Bretschneider, contends that Imtra 2011 discloses each element of claims 1, 2, 4–11, 13, 15–17, 19, 21, and 26. Pet. 26–46. Petitioner identifies where in Imtra 2011 the preamble and each limitation is purportedly found for each claim challenged as anticipated. *Id.* at 28–46.

Patent Owner responds that Petitioner’s anticipation challenge fails as a matter of law for two reasons: (1) the Petitioner fails to state the grounds for the challenge with the particularity required by statute; and (2) Petitioner improperly mixes and matches alleged features of different products in Imtra 2011 as though it is a parts catalog of features to be combined to form the claimed invention. Reply 44.

As to the first point, Patent Owner argues that 35 U.S.C. § 312(a)(3) requires an IPR Petition to identify “in writing and with particularity . . . the grounds on which the challenge to each claim is based.” Resp. 43–44. Rather than the typical manner of asserting anticipation, i.e., on a claim-by-claim basis, Petitioner identifies common limitations in the four independent claims (1, 17, 22, and 26) and argues that Imtra 2011 teaches the common

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limitations. *See* Pet. 28–37. Although this method puts additional burden on the reader to confirm that all elements of the claims are addressed, we find that Petitioner identifies the grounds for anticipation with sufficient particularity to meet the requirements of § 312(a)(3).

Patent Owner’s second point—that Petitioner improperly mixes and matches alleged features of different products in Imtra 2011—is based on the requirement that an anticipatory reference “must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.* 545 F.3d 1359, 1369–71 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). We do not “treat[] the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.” *Id.* at 1370 (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed.Cir.1984)). Nor do we find anticipation where a reference provides no link between disclosures in unrelated passages. *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed.Cir.2000) (finding no anticipation of a claim reciting use of hydrazine with a mixed resin bed to deoxygenate water where the reference contained a figure and text disclosing use of hydrogen with a mixed bed to deoxygenate water in conjunction with a separate passage discussing deoxygenating water with hydrazine). “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and,

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thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN*, 545 F.3d at 1371.

Petitioner relies on Dr. Bretschneider’s citations to pages in Imtra 2011 that contain both information regarding the properties of Imtra LEDs in general, and information on specific products. *See* Pet. 28–46. Unless the description of certain properties is expressly limited to the specific products on a given page, however, we do not view the general disclosures regarding Imtra LEDs as limited to the specific products on the same page. For example, based on our review of Imtra 2011, we understand the disclosures regarding “Anatomy of an Imtra PowerLED” on pages titled “Imtra Technology” apply to all products in the catalog. *See* Pet. 26–48; *see also* Ex. 1005, 5–13; Ex. 2045 (Colby transcript) 23:14–24 (stating that “Anatomy of a PowerLED is used somewhat universally across several product names.”). In addition, although Petitioner identifies specifically the Portland model as meeting the limitation of “wherein the heat conducting sidewall has a first dimension between the heat conducting closed rear face and the open front face of less than 2 inches,” review of the reference shows that all but two of the LED downlights disclosed in the reference meet this limitation. Thus, while Petitioner identifies specific products as exemplifying certain claim limitations, it does not follow that *only* those specific products meet the claim limitations.

In addition to arguing that Petitioner’s anticipation challenge fails as a matter of law, Patent Owner contends that Imtra 2011 discloses neither the claimed “driver” nor the claimed “plurality of elements” that align with tabs of a standard junction box. Resp. 46–51.

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1. *driver*

Petitioner directs us to the portion of Imtra 2011 indicating Imtra PowerLED fixtures include “Integrated Driver Electronics featuring,” *inter alia*, constant current control of LEDs, PWM dimming interface, and voltage spike/transient suppression. Pet. 29 (citing Ex. 1005, 5); *see also* Ex. 1002, ¶ 123. Petitioner argues that the integrated driver electronics disclosed in Imtra 2011 meet the limitation of “a driver for powering the light source module to emit light.” Pet. 29 (citing Ex. 1005, 5, 10).

Patent Owner argues that Petitioner fails to show the presence of the claimed driver in Imtra 2011. Resp. 46–47. Specifically, Patent Owner explains that Dr. Bretschneider’s declaration relies on text on page 5 (relating to Imtra PowerLED fixtures), but pictures a Ventura product, which receives low-voltage DC, rather than building mains voltage. *Id.* Patent Owner states that the Portland and Hatteras family of products also receive low-voltage DC, rather than building mains voltage. *Id.* at 47.

Thus, Patent Owner’s position is based on its proposed construction of “driver,” which we decline to adopt. Using our construction of “driver,” we are persuaded by Petitioner’s argument that the “integrated drive electronics” of generic Imtra PowerLED fixtures satisfy the “driver” limitation. *See, e.g.*, Ex. 1005, 5.

2. *plurality of elements*

Independent claims 1 and 26 (and their challenged dependent claims) require “the unified casting includes a plurality of elements positioned proximate to the open front face so as to align with corresponding tabs of a standard junction box and thereby facilitate holding the unified casting up against the standard junction box when the unified casting is installed in the

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standard junction box.” Ex. 1001, 8:27–33. Figure 1 of the ’266 Patent is reproduced below:

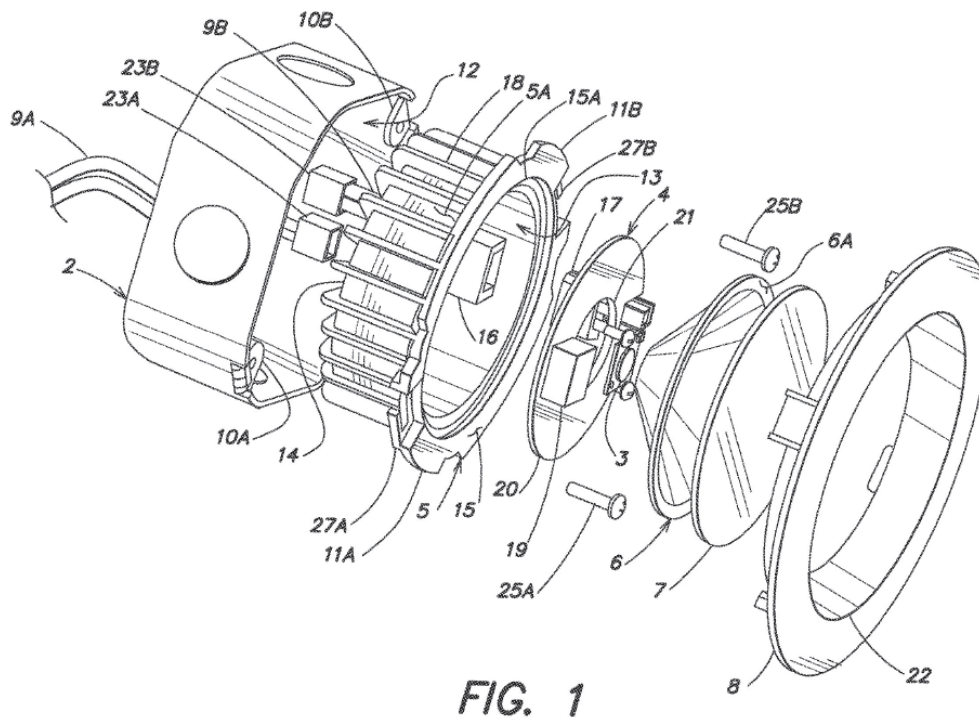


Figure 1 of the ’266 Patent shows an exploded view of a recessed lighting system. *Id.* 2:6–7. The system may include junction box 2, light source module 3, driver (power supply) 4, unified casting 5, reflector 6, lens 7, and trim 8. *Id.* 2:7–10.

The ’266 Patent describes the junction box tabs and plurality of elements for aligning with them as follows:

In one embodiment, the junction box 2 may include one or more tabs 10A, 10B for coupling the junction box 2 to the casting 5. The tabs 10A, 10B may be any device/component for receiving corresponding elements 27A, 27B of the casting 5 to firmly hold the weight of the unified casting 5, the light source module 3, the driver 4, the reflector 6, the lens 7, and/or the trim 8 up against the junction box 2. As shown in FIG. 1, the tabs 10A, 10B include holes for receiving screws or bolts 25A, 25B through the corresponding elements 27A, 27B; however, in other

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embodiments the tabs **10A**, **10B** may facilitate a twist-and-lock friction connection with corresponding elements **27A**, **27B** of the casting **5** and without the use of separate tools or other devices.

Id., 2:40–52.

Petitioner argues that Imtra 2011 discloses that the lighting devices may include mounting holes on the housing that are adapted to receive mounting screws to fasten the lighting device to a surface, such as a recessed area in the ceiling. Pet. 35 (citing Ex. 1005, 6, 10). Relying on Dr. Bretschneider’s testimony, Petitioner contends that a POSITA would have understood that the mounting holes are located on or proximate to the open front face and could be positioned anywhere on the outside surface of the housing according to the needs of the final installation method. *Id.* at 35–36 (citing Ex. 1002, ¶ 143). Dr. Bretschneider testified that “[g]iven the long history of mounting lighting fixtures to the retaining tabs on the face of a junction box, a POSITA reading Imtra’s implicit teaching of screw mount fixtures would understand that this indicates a fixture that could be mounted to the attachment points of a standard junction box.” Ex. 1002, ¶ 143.

Thus, Petitioner asserts that Imtra 2011 discloses the existence of mechanical elements built into the housing or unified casting in order to attach the lighting device to a junction box in a ceiling. Pet. 36.

Patent Owner counters that Imtra 2011 does not teach mounting its fixtures to the attachment points of a standard junction box. Resp. 51. According to Patent Owner, a POSITA reading Imtra 2011 would understand that it teaches mounting Imtra products directly to the ceiling using screws that are inserted directly into the ceiling. *Id.* at 50. Patent Owner further argues that products in Imtra 2011 were low-voltage DC devices that did not require a junction box and were not designed to mate

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with a standard junction box. *Id.* at 49.

Based on our review of the arguments and evidence of record, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that Imtra 2011 teaches the required “plurality of elements positioned proximate to the open front face so as to align with corresponding tabs of a standard junction box.” In particular, as explained below, we find Petitioner has not provided sufficient evidence to demonstrate that the mounting holes described in Imtra 2011 “comprise a plurality of elements positioned so as to align with corresponding tabs of a standard junction box.”

Imtra 2011 teaches that, in addition to mounting springs, “screw-mounted fixtures” or “mounts with screws” are options for installing the Imtra products. Ex. 1005, 5, 6, 10, 12. Petitioner and Dr. Bretschneider rely on the screw holes or mounting holes as teaching the “plurality of elements” limitation of the claims. *See* Pet. 35–36, Ex. 1002 ¶ 143. The evidence of record, however, demonstrates only that the products in Imtra 2011 are installed with mounting springs or are screwed directly into the ceiling, i.e., not using a standard junction box.

For example, Eric Braitmayer, CEO and President of Imtra Corporation, testified at his deposition that he was familiar with Imtra brochures on lighting products because he created most of the brochures, and was familiar with Imtra’s LED products in the catalogs. Ex. 2089, 10:10–11; 29:15–30:11 (Braitmayer depo.). He further testified that Imtra’s LEDs products “could be mounted to any subsurface that’s hard enough to be held in place with a screw,” and to mount the LED fixture, one would “drill small holes in the mounting surface,” for mounting the fixture to

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whatever material one wants to mount it to, typically plywood in the ceiling of a boat. *Id.* at 32:12–19; 42:22–43:6; 75:1–19. Colby Chevalier, Director of Product Management at Imtra Corporation, signed a declaration that stated “Imtra’s recessed lights are not mounted in a junction box. They are mounted in an overhead cutout in a boat ceiling either using mouse trap springs or screw holes.” Ex. 2009, 1 (Chevalier decl.).

Petitioner argues that Messrs. Braitmayer and Chevalier are not persons of ordinary skill in the art, implying that their testimony should be discounted or ignored. *See* Reply 12. However, as both men are shown to be very familiar with the Imtra products depicted in Imtra 2011, we find their testimony as fact witnesses to be credible. *See* FRE 602.

Mr. Benya testifies by declaration that Imtra 2011 has four different families of LED lights, which he refers to as the Sardinia 120 VAC Family, the Ventura Low-Voltage DC Family, the Portland Low-Voltage DC Family, and the Hatteras Low-Voltage DC Family. Ex. 2090, ¶ 251. He notes that the Sardinia 120 VAC Family products are the only Imtra products that accept 120 VAC. *Id.* at ¶ 254. He quotes Imtra 2011 as stating that the Sardinia 120 VAC Family products are “equipped with an 18-awg Triplex cable tails for direct hook-up to an AC J-box.” *Id.* at ¶ 252 (quoting Ex. 1002, 6. Mr. Benya explains:

This language means that the wire itself is hooked-up to AC power within the J-box. So when the product is installed through a hole cut into a ceiling and *attached directly to the ceiling of the boat (by springs or screws)*, the Triplex cable tail provides a length of cable that can be extended from the Sardinia/Cyprus product at one end to a distance up to the length of that cable to be connected at the other end to an AC power line within the junction box (such as by twist caps). Imtra 2011 also explains that an optional terminal block allows connection at the

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Sardinia/Cyprus product: “If preferred, attach the optional terminal block/bracket for convenient wiring right at the fixture housing.”

Id. ¶ 258 (emphasis added). Mr. Benya conveys that these devices would not need to use a junction box to mount to the ceiling because trap springs or screws are used to mount them directly to the ceiling. *Id.* ¶ 259.

Petitioner argues that Mr. “Benya agrees that because Imtra 2011 discloses screw holes, at least one of those screw holes can be aligned with any tab of any J-box and that results in the casting being installed in a J-box.” Reply 11 (citing Ex. 1038, 130:6–131:8). Petitioner’s characterization is inaccurate. Although Mr. Benya testified that it is physically possible to attach an Imtra product to a standard junction box using one screw hole, he clearly indicated this did not constitute the Imtra product being “installed” according to the manufacturer’s instructions:

Q. Well, if we take the Hatteras product depicted in the Imtra 2011 catalog as is, we could attach it to a tab of a standard junction box by placing a screw through one of the existing screw holes; correct?

* * *

[Mr. Benya]: I’m not sure I understood your hypothetical there. If I put one screw through one hole, I could attach it to a standard junction box?

Q: Correct.

[Mr. Benya]: It would stay there, but that’s not installed according to the manufacturer’s instructions. It’s not installed according to the UL or code. So, yeah, you can do it if you want to stick one screw in one hole. That’s—that’s not realistic.

Ex. 1038, 130:16–131:8. Mr. Benya’s testimony here serves more to illustrate the weakness of Petitioner’s case, as it indicates it is not “realistic” to attach an Imtra product to a J-box using one of the screw holes designed

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for attaching the Imtra product to the ceiling. Furthermore, the claims require a “plurality of elements”—meaning, more than one element—that “align with corresponding tabs”—again, more than one tab—of a “standard junction box.” Petitioner’s thought experiment of connecting a single screw through a single hole to a single tab of a junction box does not address the plain language of the claims.

In his declaration Dr. Bretschneider, Petitioner’s expert, testified that a “POSITA could easily select from the large number of commercially available junction boxes, a junction box having tabs that align with the mounting holes shown in Imtra 2011.” Ex. 1002, ¶ 144. Despite this statement, however, Dr. Bretschneider testified at deposition that he did not identify in his declaration any standard junction box whose tabs would align with a plurality of elements of any of the products described in Imtra 2011. Ex. 2047, 185:18–22, 187:6–188:2, 190:13–17. He also testified that not all junction boxes have mounting tabs or holes to mount a lighting fixture. *Id.* 51:16–19, 53:13–16. Dr. Bretschneider testified that a low voltage power supply does not require use of a UL junction box, with the exception of a Class 1 environment that includes the presence of flammable or explosive materials in the air. *Id.* at 120:19–121:3, 122:8–15, 124:9–17.

Petitioner argues “J-boxes are well known and provide a convenient mounting surface” and “J-boxes are also known to be used on boats.” Reply 12. But the assertion does not address the claim limitation that the plurality of elements (alleged to be mounting holes in the Imtra products) are positioned proximate to the open front face (of the fixture) so as to align with corresponding tabs of a standard junction box. And Petitioner does not direct us to any discussion of attaching a product from Imtra 2011 to a

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standard junction box in the catalog itself.

Petitioner has the burden of showing unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). Claims 1, 2, 4–11, 13, 15, 16, 19, 21, and 26 all require a unified casting having “a plurality of elements” that “align with corresponding tabs of a standard junction box.” *See* Ex. 1001, 8:27–30, 12:15–17. For the reasons discussed above, Petitioner fails to demonstrate by a preponderance of the evidence that Imtra 2011 discloses a unified casting having “a plurality of elements” that “align with corresponding tabs of a standard junction box.” *See* Ex. 1001, 8:27–30, 12:15–17. As a result, we determine that Petitioner has failed to demonstrate that Imtra 2011 anticipates claims 1, 2, 4–11, 13, 15, 16, 19, 21, or 26.

Claim 17 is the only challenged claim that does not recite a unified casing having a “plurality of elements” aligning with corresponding tabs of a standard junction box. *See id.* 10:3–34. With regard to claim 17, Patent Owner argues that the anticipation challenge fails as a matter of law—an argument that we reject for the reasons discussed above—and Imtra 2011 does not disclose the claimed driver based on a construction of driver that we do not adopt. *See* Resp. 46–51. Patent Owner does not otherwise dispute Petitioner’s evidence or arguments that Imtra 2011 discloses each limitation of claim 17. We have reviewed Petitioner’s undisputed evidence and arguments regarding the disclosure of Imtra 2011, and agree with and adopt Petitioner’s evidence and reasoning presented in the Petition regarding claim 17. As a result, we find that Petitioner has demonstrated by a preponderance of evidence that Imtra 2011 discloses each limitation of claim 17. Therefore, we find Imtra 2011 anticipates claim 17.

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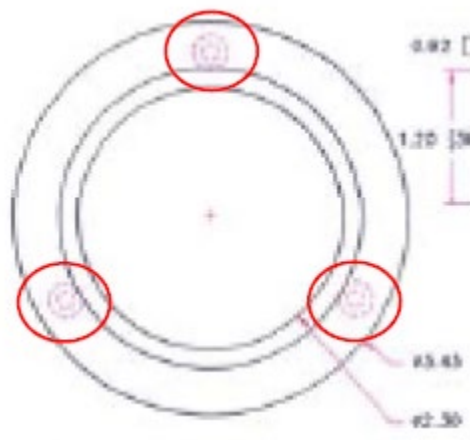
F. Ground 2: Obviousness over Imtra 2011 and Imtra 2007

Petitioner contends that claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, and 28–30 would have been obvious over the combination of Imtra 2011 (Ex. 1005) and Imtra 2007 (Ex. 1006). Pet. 47–64. Claims 14, 22, 25, and 28–30 were not challenged as anticipated in Ground 1. *See id.* at 26. Petitioner relies on Imtra 2007 for its disclosure of certain features of some products in the catalog to meet limitations in claims 14, 22, 25, and 28–30. *See id.* at 50–55. Petitioner relies on Imtra 2007 as showing additional details about some products that allegedly confirm the products include any limitations missing in the anticipation analysis. Reply 13.

Petitioner argues that a POSITA would have been motivated to combine the disclosures of Imtra 2011 and Imtra 2007 in order to “understand the technology involved in the products.” Pet. 49.

In Ground 2, Petitioner argues that Imtra 2011 combined with Imtra 2007 disclose the “plurality of elements” limitation. *Id.* at 49–50. Petitioner contends:

[M]ounting holes described in Imtra 2011 are “illustrated in a diagram for the Portland PowerLED in the Imtra 2007 catalog (circled in red below):



Thus, the Imtra references disclose the existence of mechanical

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elements built into the housing or unified casting in order to attach the lighting device to a ceiling, proximate the open front face, and that the lighting devices “can be easily installed in shallow ceiling depth locations.” (Imtra 2011, p. 6) It would be an obvious design choice to align these screw holes with tabs of a standard junction box. (Bretschneider, ¶118, 144) *See Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 1345, 1346 (Fed. Cir. 1984).

Pet. 51–52; *see also* Reply 14–15. Petitioner argues that Mr. Benya concedes that Imtra 2007 discloses a Portland PowerLED having a flange with screw holes and a Hatteras PowerLED with a casting with a flange with screw holes. Reply 14–15 (citing Ex. 1038, 221:–222:1, 223:17–225:1). Based on the presence of screw holes in the flanges, Petitioner states “[t]herefore, it is *undisputed* that Imtra 2007 discloses the ‘plurality of elements’ limitation.” *Id.* at 16 (emphasis added).

We disagree with Petitioner’s ultimate conclusion that Imtra 2007 discloses the plurality of elements limitation, at least for the reasons discussed above in relation to Imtra 2011 and the “plurality of elements” limitation.

In addition, review of the portions of Mr. Benya’s deposition testimony cited by Petitioner shows that Mr. Benya merely agreed that drawings in Imtra 2007 of a Portland PowerLED and a Hatteras PowerLED reasonably indicated that the products include a flange with a screw hole in them. *See* Ex. 1038, 220:19–225:1. Petitioner tried, but failed, to get Mr. Benya to agree that “if the Hatteras product had a larger flange such that the screw holes would align with the tabs of the standard junction box,” it would meet the “plurality of elements” limitation. *Id.* 127:22–130:14. Thus, Mr. Benya did not agree that Imtra 2007 “discloses the ‘plurality of elements’

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limitation.”

We also disagree with the characterization that Patent Owner did not dispute that Imtra 2007 discloses the ‘plurality of elements’ limitation.”. Patent Owner points to Dr. Bretschneider’s single sentence about modifying Imtra 2011 (presumably with Imtra 2007) in the section of his declaration discussing the “plurality of elements” limitation:

Alternatively, modifying the junction points for screw mount fixtures to match those attachment points of a standard junction box would easily be within the capability of a POSITA and yield predictable results without the need for undue experimentation.

Resp. 55 (quoting Ex. 1002 ¶ 145). Patent Owner argues that a statement about whether one is “capable” of modifying Imtra to have screw holes to align with a standard junction box does not explain adequately why a POSITA would have reason to make such a modification. *Id.* As discussed above in relation to Ground 1, Patent Owner spells out that the products in Imtra 2011 (the same products as in Imtra 2007) do not need a junction box for installation and argues that a POSITA would not indulge in the added time, labor, and expense to add an unnecessary junction box in order to mount a fixture that it already readily mounted directly to the ceiling. *Id.* at 55–56.

Petitioner’s reasoning is that the Imtra references (either or both) *would have allowed for* modification of Imtra products such that they could be mounted in a standard junction box. Such reasoning is insufficient, as it merely portrays the possibility of modifying Imtra products, i.e., that they *could be* modified, not that there was a reason to modify the products, i.e., that a POSITA *would have* modified the products. *See PersonalWeb Techs., LLC, v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (holding that two

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references could be modified does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention).

“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). Petitioner’s and Dr. Bretschneider’s analysis succumb to hindsight bias in failing to explain *why* a POSITA would modify the Imtra products to arrive at the claimed invention. *See InTouch Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (finding hindsight where expert testified that a POSITA *could* combine references, not that they *would* have been motivated to do so).

Patent Owner also identifies problems with Dr. Bretschneider’s conclusory motivations for modifying Imtra in the section of his declaration concerning motivation to combine the Imtra references:

A POSITA, having the basic knowledge of how light sources, including compact LED-based light sources, can be recessed into a can-like fixture of a convention junction box, would be motivated to seek alternative ways to affix the Imtra lighting devices into such a device.

Resp. 56 (quoting Ex. 1002 ¶ 117). Specifically, Patent Owner accurately establishes that Petitioner fails to show that a POSITA would have basic knowledge of how compact LED-based light sources can be *recessed* into a standard junction box, absent use of the ’266 patent. *Id.* (citing Ex. 2090, ¶ 322). For example, Dr. Bretschneider presents a discussion of surface mount lights, in the Background section of his declaration, but surface mount lights in which the LED light source is below the junction box and the ceiling are different from the claimed “recessed lighting system.” *Id.*

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And neither Imtra brochure discloses mounting an LED light source inside a junction box. *Id.* at 56–57. Moreover, Dr. Bretschneider fails to explain *why* a POSITA would have incurred the additional time and money to mount a compact LED-base light source inside a standard junction box, when the fixture could be mounted directly to the ceiling. Thus, there is insufficient evidence that a POSITA *could have* mounted the recessed fixture in a standard junction box, and no explanation of why a POSITA *would have* done so.

Moreover, that Imtra products could be installed in shallow ceiling depth locations (Ex. 1005, 6), are easily fixed to a mounting surface with fasteners (*id.*, 10), and have screw holes (*id.*, 5) does not support Dr. Bretschneider’s conclusion that a POSITA would be led by this information to dimension and position screw holes to allow attachment to the tabs of a standard junction box. *See* Ex. 1002 ¶ 118. Again, that something *could be* done does not provide a reason why a POSITA *would have had a reason* to make that effort. *See Belden*, 805 F.3d at 1073.

Petitioner and Dr. Bretschneider provide no credible reason why a POSITA would make the proposed modifications so that a plurality of elements would align with corresponding tabs of a standard-sized junction box. Therefore, we find that Petitioner fails to show obviousness of claims 1, 2, 4–11, 13–16, 19, 21, 25, 26, and 28–30 over the combination of Imtra 2011 and Imtra 2007 by a preponderance of the evidence. Claim 17 would have been obvious over the combined references for the same reasons it is anticipated by Imtra 2011. *See In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) (“[A]nticipation is the epitome of obviousness.”).

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G. Ground 3: Obviousness over Imtra 2011, Imtra 2007, and Gifford

Petitioner challenges claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, and 28–30 as obvious over the combination of Imtra 2011 (Ex. 1005), Imtra 2007 (Ex. 1006), and Gifford (Ex. 1007). Pet. 64–73. Petitioner argues that Gifford explicitly discloses mounting elements that align with a standard junction box. *Id.* at 64. Petitioner contends that Gifford teaches that compact lighting systems may be recessed within an electrical junction box suitable for installation in a ceiling. *Id.* at 65 (citing Gifford, Fig. 1; 3:19–27). Similar to its arguments in Ground 2, Petitioner contends that a POSITA with knowledge of how compact LED-based light sources can be recessed into a conventional junction box would have been motivated to seek alternative ways—such as Gifford—to affix Imtra lighting devices into such a box. *Id.* at 67. According to Petitioner, “[a] POSITA would have been motivated to apply the teaching of Gifford that a housing for components of a compact LED lighting device can be asserted [sic] into and attached to a standard junction box” and “[a] POSITA would have been motivated to do so for a number of reasons.” *Id.*

According to Dr. Bretschneider:

Gifford teaches installation of an LED lighting fixture to a standard junction box using an adapter apparatus that includes a hollow recess with a back wall and side walls that are contiguous. Gifford also teaches installation of an electrical converter that converts power mains (e.g., 110 V AC) to low voltage DC in order to supply and regulate electrical energy to the LED module.

Thus[,] a POSITA understands that Imtra and Gifford teach related devices that include many common features. Combining the elements and features of Imtra and Gifford would be within the capabilities of a POSITA and would yield predictable results.

Ex. 1002, ¶¶ 120–121.

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In its Reply, Petitioner states that it relies on Gifford for showing an LED system having a housing with an integral flange with screw holes that align with a J-box. Reply 16. Petitioner argues “[t]here is no question that Gifford discloses use of a standard J-box having integral tabs that may be used to attach a lighting device.” *Id.* at 17. A POSITA, according to Petitioner, would have understood that modifying the flange with screw holes that align with tabs of J-box as taught by Gifford would involve simply modifying the prior art using well-known methods to yield predictable results. *Id.* at 17.

Patent Owner raises similar arguments to those made in disputing the prior grounds, i.e., Ground 3 fails as a matter of law for lack of clarity and mixing-and-matching product features in Imtra 2011; Imtra 2011 devices do not require a junction box and were not designed to mount to a junction box (citing Ex. 2090 ¶ 339); a POSITA would not have been motivated to incur the time, labor, and expense of using an unnecessary junction box with Imtra 2011 products; and Petitioner provides no motivation other than hindsight to combine Imtra 2011, Imtra 2007, and Gifford to result in the invention of the ’266 patent. Resp. 58–63. More specifically, regarding motivation, Patent Owner argues that adding Gifford as a reference “does not alter the reasons explained for Ground 2 (Imtra 2011 and Imtra 2007) why a person skilled in the art would not be motivated to modify and mount an Imtra 2011 device directly to a junction box.” *Id.* at 61.

Mr. Benya testifies that Dr. Bretschneider alleges that Gifford’s adapter apparatus is “equivalent” to the unified casting of the ’266 patent. Ex. 2090 ¶ 349 (citing Ex. 1002 ¶¶ 111–112 stating “Gifford’s adaptor apparatus is equivalent to the casting of the ’266 patent”). Mr. Benya points

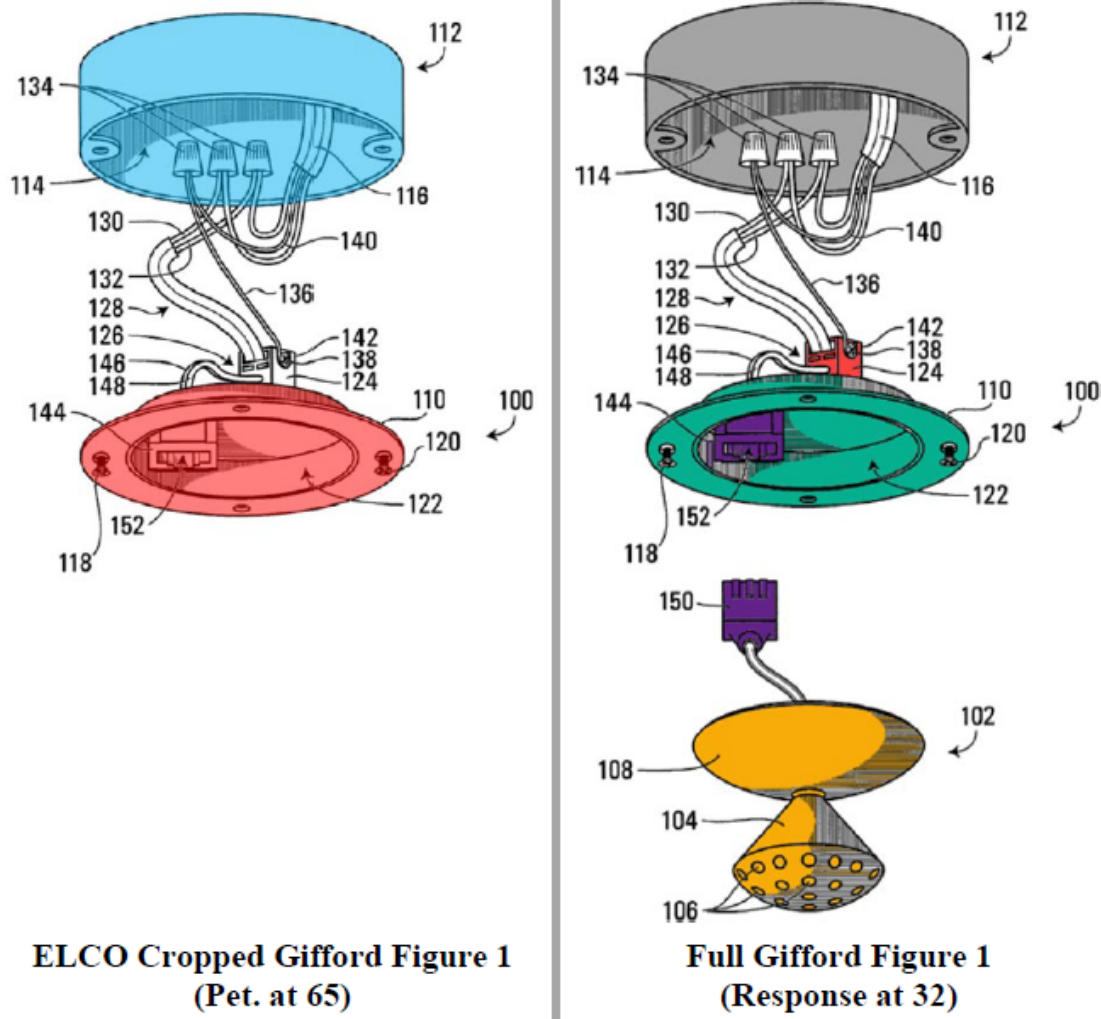
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out that Gifford discloses mounting surface mounted lights, not recessed lights. *Id.* Patent Owner argues that what Petitioner describes as a “housing” in Gifford is not a housing, but rather, a safety apparatus. Sur-reply 28; *see also* Reply 16 (“The Petition relies on Gifford for showing an LED system having a housing with an integral flange with screw holes that align with a J-box.”).

Patent Owner contends that Petitioner employed hindsight in creating the cropped Fig. 1 of Gifford in the Petition and misidentified its components. Sur-reply 30. Patent Owner provides a side-by-side comparison of Petitioner’s “cropped” Fig. 1 of Gifford with the full Fig. 1 of Gifford:

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Reply 29. The left side of the above figure shows Gifford's electrical junction box 112 and adaptor apparatus 100, but not light fixture apparatus 102. *See* Gifford, 3:19–27. The right side of the above figure shows the entirety of Gifford's Fig. 1, including electrical junction box 112, adaptor apparatus 100, and light fixture apparatus 102. *See id.*, 3:11–18.

The left side of the figure above is reproduced from the Petition, and is a partial reproduction of Gifford Fig. 1. *Compare* Pet. 65 with Gifford, Fig. 1. Petitioner describes its depiction as:

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Gifford teaches that *such compact lighting systems may be recessed within an electrical junction box* suitable for installation in a ceiling. (Gifford, Fig. 1; 3:19-27) Gifford shows that adapter apparatus 100 having a support 110 (highlighted in red) that is inserted into and attaches to a junction box 112 (highlighted in blue).

Pet. 65 (emphasis added).

The side-by-side comparison figure as explained by Patent Owner shows:

The right-side image above shows the *complete* Figure 1 where the adapter apparatus 100 is highlighted green. The bottom part that ELCO cropped-out is “light emitting diode (LED) light fixture apparatus 102” (highlighted yellow) (Gifford, 3:8-10). It has a “ceiling canopy 108” to “hide[] the adaptor apparatus 100 from view” and a “lighting element 104 [that] includes a plurality of Light Emitting Diodes (LEDs) 106.” (Gifford, 3:11-18). The adapter apparatus 100 has a “connector 144 [that] is configured to receive a connector 150 of the light fixture apparatus 102 for powering the LED lighting element 104” (highlighted purple). Accordingly, the adaptor apparatus 100 does not house lighting fixture components at all; they are housed in the lighting fixture 102 hanging below it.

Sur-reply 29–30.

Upon evaluation, we agree with Patent Owner that the version of Figure 1 included in the Petition does not fully characterize the teachings of Gifford. In particular, we note that Figure 1 shows that Gifford’s light emitting diode is positioned outside its adaptor apparatus, and therefore is not recessed into the ceiling inside an electrical junction box. Petitioner’s statements to the contrary (Pet. 65) are unsupported by the evidence of record.”

We find that Petitioner fails to prove by a preponderance of the evidence that a POSITA would have been motivated to modify the Imtra

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references in view of Gifford's teaching.

Petitioner cites to several paragraphs of Dr. Bretschneider's declaration to support a reason to modify the Imtra products in view of Gifford. Reply 22 (citing Ex. 1002, ¶¶ 117–121, 134, 143–145, 175, 177–78, 185–86, 199). As set forth below, review of these paragraphs, however, shows that they are repetitive, conclusory, and suffer from the defect of surmising what a POSITA *could have* done instead of what a POSITA *would have had reason* to do, as discussed in Ground 2.

Paragraphs 117–19 of the Bretschneider Declaration discuss Imtra, but do not mention Gifford. Ex. 1002, ¶¶ 117–19.

Paragraph 120 of the Bretschneider Declaration states that Gifford teaches installation of an LED lighting fixture to a standard junction box using an adaptor apparatus that includes a hollow recess with a back wall and side walls that are contiguous. Paragraph 121 of the Bretschneider Declaration concludes that a POSITA understands that Imtra and Gifford teach related devices that include many common features, such that combining the elements and features would be within the *capabilities* of a POSITA and would yield predictable results.

Paragraph 134 of the Bretschneider Declaration discusses the dimensions of a junction box described in the '266 patent.

Paragraphs 143–45 of the Bretschneider Declaration discuss Imtra 2011 and do not mention Gifford.

Paragraph 175 of the Bretschneider Declaration states—incorrectly—that Gifford teaches a lighting system that is able to be installed in a standard junction box. As shown in the figure above, Gifford discloses components of electrical converter 124 housed in electrical junction box 112 and above

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adaptor apparatus 100. Gifford, Fig. 1, 4:22–30. Connector 150 sits within a recess in adaptor apparatus 100. *Id.*, Fig. 1, 4:41–46. Gifford’s lighting fixture 102 is located on the exterior of adaptor apparatus 100 and is not recessed. Therefore, Gifford does not teach a lighting system able to be installed in a standard junction box. Paragraph 175 further states that a POSITA would be motivated to combine Imtra 2011 with Gifford, but as the premise on which the conclusion is based is wrong, we disagree with Dr. Bretschneider’s conclusion.

Paragraphs 177–78 of the Bretschneider Declaration state that a POSITA would be motivated to reposition the mounting holes of Imtra 2011 to match the tab locations of a standard junction box as the tab locations of a standard junction box form a mounting surface. This faulty reasoning assumes a POSITA would seek to incur additional expense in time, labor, and materials to mount an Imtra fixture in a junction box, rather than simply screw it into the ceiling. Petitioner provides no credible reason why a person of ordinary skill in the art would have made the proposed modifications.

Paragraph 185 of the Bretschneider Declaration addresses Imtra 2011, not Gifford. Paragraph 186, like paragraph 121, states that a POSITA would be motivated to combine Gifford with Imtra 2011, since such a modification would be within the *capability* of a POSITA and would give predictable results.

Paragraph 199 of the Bretschneider Declaration states that a POSITA would be motivated to modify the position of the screw attachment holes of Imtra 2011 to correspond to the mounting tabs of a standard junction box in light of the teachings of Gifford, as both are directed to lighting products

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that install in shallow recesses and the combination would result in predictable results. However, as discussed above, Gifford is not directed to a lighting product that installs in a shallow recess, it is directed to a surface mount light fixture. Thus, Petitioner provides no adequate reason for making the proposed modification.

And Petitioner provides no evidence that enlarging the flange of the Hatteras product depicted in Imtra 2007 would result in screw holes aligned with the tabs of a standard junction box, or why a POSITA would be motivated to make any modification. *See, e.g.*, Reply 20–21. Instead, Petitioner argues that Patent Owner fails to show evidence that a POSITA would have been unable to modify the Imtra products—which improperly attempts to transfer Petitioner’s burden of proof to Patent Owner.

Dr. Bretschneider’s conclusion that Gifford’s adaptor apparatus is “equivalent” to the unified casting of the ’266 patent (Ex. 1002, ¶¶ 111–112) is also not credible. As Dr. Bretschneider acknowledges, the back and exterior of Gifford’s adaptor apparatus has no fins or other heat dissipation feature. *See* Ex. 1002 ¶ 112. In addition, the adaptor apparatus does not contain a lighting system, nor does Gifford suggest that a lighting system could be contained within the adaptor apparatus. *See* Gifford, Fig. 1.

Finding insufficient evidence regarding a reason to combine the Imtra references with Gifford, we not are persuaded that Petitioner demonstrates, by a preponderance of the evidence, that the subject matter of any of challenged claims 1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, and 28–30 of the ’266 patent would have been obvious over the combination of Imtra 2011, Imtra 2007, and Gifford.

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III. MOTIONS TO EXCLUDE

A. Petitioner's Motion to Exclude

Petitioner seeks to exclude paragraphs 4–6 of the declaration of Mr. Colby Chevalier dated June 3, 2019 (Ex. 2009), on the basis that he lacks personal knowledge and his deposition testimony exceeds the scope of the direct examination. Paper 53, 3–5. In these paragraphs Mr. Chevalier testifies that Imtra's recessed light are not mounted in a junction box, boats do not use junction boxes, and anyone wanting to put Imtra's lights in a junction box would be on the wrong path. Ex. 2009 ¶¶ 4–6. At the time of his declaration, Mr. Chevalier was the Director of Product Management for Imtra Corporation and had been with Imtra for more than 13 years. *Id.* ¶ 1. As such, we consider Mr. Chevalier to be qualified to provide fact testimony regarding Imtra's products. We deny Petitioner's motion to the extent that it requests exclusion of fact testimony, and dismiss it as moot to the extent that it requests exclusion of opinion testimony, as we did not rely on Mr. Chevalier's opinions in our decision.

Petitioner also seeks to exclude pages of Mr. Chevalier's deposition testimony (Ex. 2045). Paper 53, 5–6. We dismiss this portion of the motion as moot as we do not rely on these portions of Mr. Chevalier's testimony in this Decision.

Petitioner seeks to exclude evidence on copying and praise, including Mr. Benya's opinions (Ex. 2090 ¶¶ 120–136, 138–142, 144–147, and 159–160) and Exhibits 2052–2073, 2076, 2077, 2080, and 2081. Paper 53, 6–14. We dismiss this portion of the motion as moot as we do not rely on this evidence in this Decision.

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We also dismiss Petitioner's motion to exclude paragraphs 35–36 of Mr. Benya's declaration as moot as we do not rely on them in this Decision.

B. Patent Owner's Motion to Exclude

Patent Owner seeks to exclude images at pages 20–21 of the Reply, as well as Exhibits 1010–1028. Paper 59, 1–3 and 6–9. We dismiss this portion of the motion as moot as we do not rely on this evidence in this Decision.

Patent Owner also seeks to exclude paragraphs 67, 106, 107, 117, and 147 of Dr. Bretschneider's declaration (Ex. 1002). *Id.* at 3–5. We dismiss the motion as moot with respect to paragraphs 67, 106, 107, and 147, as we do not rely on this testimony in this Decision.

We deny the motion with respect to paragraph 117. Patent Owner argues that paragraph 117 should be excluded under FRE 401–403 as irrelevant to the analysis of a motivation to combine. Paper 59, 4–5. Paragraph 117 states:

The Imtra references teach that its lighting devices are well suited for installations with limited space, such as marine applications with shallow ceiling depths and limited overhead space [Exh. 1005, Imtra 2011, p. 6] The Imtra references teach mounting the lighting devices directly to the ceiling by springs or screws but does not detail using a standard junction box. The Imtra references also teach mounting switches using standard junction boxes. A POSITA, having the basic knowledge of how light sources, including compact LED-based light sources, can be recessed into a can-like fixture of a conventional junction box, would be motivated to seek alternative ways to affix the Imtra lighting devices into such a device.

Ex. 1002, ¶ 117. Petitioner argues that paragraph 117 provides relevant evidence and there is no danger of confusion or unfair prejudice. Paper 55,

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3–5. We deny Patent Owner’s motion to exclude paragraph 117, as we find it to be relevant and probative.

IV. PATENT OWNER’S MOTION TO SEAL

Patent Owner moves to seal Paper 49 and Exhibits 2061–2073, 2075, 2076, 2088, 2090, and 2110. Paper 67. Patent Owner asserts that the exhibits sought to be sealed (other than Exhibits 2090 and 2011) were produced in co-pending district court litigation involving the ’266 patent and contain sensitive business information. *Id.* at 1–2. Patent Owner asserts that Paper 49 (Patent Owner’s Sur-reply) and Exhibits 2090 and 2110 were filed under seal in accordance with 35 U.S.C. § 316(a)(1) and remain under seal pending the outcome of the motion. *Id.* at 2. Petitioner did not oppose Patent Owner’s motion. *See id.* at 4.

A non-confidential version of Paper 49 was filed as Paper 50. A non-confidential version of Exhibit 2090 was filed as Exhibit 2094. A non-confidential version of Exhibit 2110 was filed as Exhibit 2111.

“There is a strong public policy for making all information filed in a quasijudicial administrative proceeding open to the public, especially in an *inter partes* review which determines the patentability of claims in an issued patent and therefore affects the rights of the public.” *Garmin Int’l v. Cuozzo Speed Techs., LLC*, IPR2012–00001, slip op. at 1–2 (PTAB Mar. 14, 2013) (Paper 34). For this reason, except as otherwise ordered, the record of an *inter partes* review trial shall be made available to the public. *See* 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.14.

The standard for granting a motion to seal is good cause. 37 C.F.R. § 42.54. That standard includes a showing that “(1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon

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public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4) on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.” *Argentum Pharms. LLC v. Alcon Research, Ltd.*, Case IPR2017-01053, slip op. at 4 (Paper 27) (PTAB Jan. 19, 2018) (informative).

After having considered the Motion, we determine that there is good cause for granting it. Specifically, Patent Owner demonstrates that the information it seeks to seal consists of confidential commercial information. And we see little harm to the public’s interest in restricting access to the information because we do not rely on any confidential information in this decision. We further note that the public versions of Petitioner’s Sur-reply, Exhibit 2090, and Exhibit 2111 appear to redact only that information that Patent Owner seeks to seal in its motion, and the redactions are narrowly tailored.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has not established, by a preponderance of the evidence, that claims 1, 2, 4–11, 13, 15, 16, 19, 21, or 26 of the ’266 patent are unpatentable;

FURTHER ORDERED that Petitioner has established, by a preponderance of the evidence, that claim 17 is unpatentable;

FURTHER ORDERED that Petitioner’s Motion to Exclude (Paper 53) is dismissed-in-part as moot and denied-in-part;

FURTHER ORDERED that Patent Owner’s Motion to Exclude (Paper 59) is dismissed-in-part as moot and denied-in-part;

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FURTHER ORDERED that Patent Owner's Unopposed Second
Motion to Seal (Paper 67) is granted.

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Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 2, 4–11, 13, 15–17, 19, 21, 26.	102(a)	Intra 2011	1, 2, 4–11, 13, 15, 16, 19, 21, 26.	17
1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, 28–30	103	Imtra 2011, Imtra 2007	1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, 28–30	17
1, 2, 4–11, 13–17, 19, 21, 22, 25, 26, 28–30	103	Imtra 2011, Imtra 2007, Gifford	1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, 28–30	17
Overall Outcome			1, 2, 4–11, 13–16, 19, 21, 22, 25, 26, 28–30	17

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